Docket No.: SA9-98-050 (12780.315)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Chin et al.**

Application No.:   **09/161,073**   Group No.:   **2176**

5 Filed: **09/25/1998**   Examiner: **BASHORE, William L.**

For: **INTERFACE FOR PROVIDING DIFFERENT-LANGUAGE VERSIONS OF MARK-UP-LANGUAGE RESOURCES**

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Commissioner for Patents

P.O. Box 1450, Alexandria, VA 22313-1450

APPEAL BRIEF (37 C.F.R. § 41.31)

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This brief is in furtherance of the Notice of Appeal, filed in this case herewith (on same date).

The fees required under § 41.20, and any required petition for extension of time for filing

20 this brief and fees there for, are dealt with in the accompanying documents.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)(1)):

25 The final page of this brief bears the practitioner's signature.

I. REAL PARTY IN INTEREST
(37 C.F.R. § 41.37(c)(1)(i))

The real party in interest in this appeal is International Business Machines Corporation, a
5   New York corporation of New Orchard Road, Armonk, New York, which is assignee of the
entire right, title and interest to the invention in the United States and in all foreign countries.

II. RELATED APPEALS AND INTERFERENCES
(37 C.F.R. § 41.37(c)(1)(ii))

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With respect to other appeals or interferences which may be related to, that will directly
affect, or be directly affected by or have a bearing on the Board's decision in this appeal, this
case was previously the subject of Appeal No. 2004-1077.

The Board in Appeal No. 2004-1077 affirmed the examiner's decision rejecting claim 3-
15   16 and 18-22 under 35 U.S.C. § 112, second paragraph and reversed the rejection of claims 3-16
and 18-22 under 35 U.S.C. § 103 for technical reasons. Subsequent amendment to the claims has
now resulted in removal of the 35 U.S.C. § 112, second paragraph rejections but not the 35
U.S.C. § 103 rejections, which are now partially the subject of this present appeal.

There are no other appeals or interferences which may be related to, that will directly
20   affect, or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS
(37 C.F.R. § 41.37(c)(1)(iii))

25   The status of the claims in this application are:

A. Total Number Of Claims In The Application
Claims in the application are: 1-24

30   ## B. Status Of All Of The Claims
1. Claims rejected: 3-16 and 18-22
2. Claims allowed or confirmed: NONE

3. Claims withdrawn from consideration: NONE

4. Claims objected to: NONE

5. Claims canceled: 1-2, 17 and 23-24

5   **C. Claims On Appeal**

The claims on appeal are: 3-16 and 18-22

IV. STATUS OF AMENDMENTS
(37 C.F.R. § 41.37(c)(1)(iv))

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It is understood that all amendments in the case have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER
(37 C.F.R. § 41.37(c)(1)(v))

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The present invention provides internationalization of a user interface. One task in this is converting the user-visible interface into a local language (other possible tasks include selection a correct character set and displaying dates, times, and currency codes as locally customary). See e.g., pg. 1, ln. 19 to pg. 2, ln. 8.

20   Historically, internationalization has usually been achieved by selecting among a plurality of pre-built page/frame(s) at a server or by translation at an end user's local browser (e.g., pg. 2, ln. 9-14). The latter presumes that a capable dictionary in the desired language is also present at the user's end.

The meaning of the terms "translation" and "replacement" are especially important in this
25   invention and in this appeal. The term "translation" is often used very loosely, sometimes so much so that it is used as a synonym for "replacement." [*Throughout the following we respectfully ask the reader to be vigilant and ask themselves which actually applies.*]

<u>Claim 3</u> is for a computer implemented user interface, such as the exemplary web based user interface **18** in FIG. 3. Claim 3 includes two major elements: a markup-language encoded
30   template and a plurality of resource files. FIG. 2 depicts examples of these, as a HTML template **22** and two HTML ResourceBundles **24a**, **24b**, respectively, and further depicts how the markup-language encoded template particularly includes a replacement variable **51** for replacement with

data from one of the resource files. Each of the resource files contains an idiomatically-correct predefined passage of text in a different language to replace the replacement variable when that particular resource file is selected. The replacement variable is thus always replaced with the same data/text when any given resource file is selected. Of course, in a typical usage scenario, a

5   markup-language encoded template might include multiple replacement variables and the resource files would then include multiple corresponding idiomatically-correct predefined passages of text, each in the respective language.

The figures, particularly FIG. 2 here for claim 3, provide an example. An HTML template **22** and two HTML ResourceBundles **24a, 24b** reside on a server **12** that is connected to

10   a browser **14** by the internet **16** (see also pg. 5, ln. 16-22). The HTML template **22** and one of the two HTML ResourceBundles **24a, 24b** are combined at the server **12**, into constructed HTML code **46** that is provided to the browser **14** for display there on an associated display screen **20** (FIG. 3).

The invention permits performing internationalization of a web based user interface **18** on

15   a server **12** – not on a browser **14**. It combines a selected HTML ResourceBundle **24a** or **24b** with the HTML template **22** on the server **12**, and it is the resulting constructed HTML code **46** that is then sent onward to the browser **14**. The use of the HTML ResourceBundles **24a, 24b** is then finished and these are not sent to the browser.

As discussed in the specification (pg. 2, ln. 9 to pg. 3, ln. 11), HTML page/frames and

20   Java applet panels are built at different times and places. While HTML page/frames are constructed on a web server prior to down loading, Java applet panels (e.g., Java code **25** and Java ResourceBundles **28**, to the extent that events ever require them) are down loaded to and then executed on a browser, i.e., on an end user's own machine.

The example used in the specification is a sophisticated one that is hyper-text markup

25   language (HTML) based and further includes an instance of conventional Java code **25** and a JAR file **26** containing two Java ResourceBundles **28**. In many cases Java code **25** and JAR files **26** will not be present, since the invention does not require them. If these are present, however, they may be used for conventional other purposes entirely or they may be used to provided additional internationalization capabilities (e.g., claims 9-10, which depend from claim 3). In the

30   latter case, only appropriate Java ResourceBundles **28** selected at the browser need be sent. For instance, the Java code **25** can be a Java applet **60** for a button **62** and an associated dynamic

operation that a user may activate at the browser **14**. The Java ResourceBundles **28** provided by the browser may now be limited and selected to permit internationalization completion for dynamic elements of the user interface **18** that corresponds with the already performed internationalization of the static elements while still at the server (pg. 7, ln. 21 to pg. 9, ln. 8).

5   Claim 4 adds the limitation that the resource file is selected based on a language code, e.g., language code **44** discussed at pg. 7, ln. 7-18 (mid paragraph).

Claim 5 add the limitation that the resource file is an HTML ResourceBundle, as already discussed, and claim 6 adds the limitation that the HTML ResourceBundle is alike in format to a conventional Java ResourceBundle (i.e., as key/value pairs in a Java subclass, pg. 2, ln. 19-21).

10   Claim 9 adds the limitation that the markup-language encoded template does include Java code and that a JAR file containing a Java ResourceBundle is provided. These can be used at the server to there construct the constructed HTML code (the HTML ResourceBundle is a Java ResourceBundle), or in the manner of claim 10, or in a combination of these.

Claim 10 adds the limitation that the constructed HTML code (including Java code) and

15   the Jar file are both sent to the browser, for use there in one of the manners already discussed.

Claim 11 is for a method for constructing a web based user interface, such as that just described for claim 3. An HTML template is provided (e.g., in step **32** in FIG. 1) to a server, such as the HTML template **22** and the server **12** of FIG. 2. The HTML template includes at least one variable (e.g., replacement variable **51**). A plurality of data files (e.g., HTML

20   ResourceBundles **24a**, **24b**) are also provided (step **34**) to the server, each having a different language data portion of idiomatically-correct predefined content that corresponds with the variable. One of the plurality of data files is selected (step **42**) and an HTML encoded user interface file is constructed (step **48**) by always substituting the same data portion from the selected data file into the HTML template to replace the variable.

25   FIG. 1 includes Java related steps **36, 52, 64**. As discussed above, these can be optional and used for other conventional purposes or they may be provided and used for additional internationalization (e.g., as used in claims 12-13, which depend from claim 11).

Claims 12-13, respectfully, include method step limitations that do what claims 9-10 do, as discussed above. And claim 14 adds the language code limitation discussed above for claim 4.

30   **Claim 21** is for a computer program product comprising a computer usable medium having a computer readable code embodied thereon configured to operate on a computer. A

markup-language encoded template is provided, e.g., the HTML template **22** having a replacement variable **51**. A plurality of resource files (e.g., HTML ResourceBundles **24a, 24b**) are also provided, containing data for replacing the replacement variable when that resource file is selected. The resource files each contain an idiomatically-correct predefined passage of text in

5   a different language such that the replacement variable is always replaced with that passage, as governed by the selection of a particular resource file.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
(37 C.F.R. § 41.37(c)(1)(vi))

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A. Whether claims 3, 5-6, 11, 16, 18-22 are unpatentable under 35 U.S.C. § 103(a), over Motoyama (hereinafter Motoyama), U.S. Patent No. 6,208,956 issued March 2001, in view of Fukumochi et al. (hereinafter Fukumochi), U.S. Patent No. 5,644,774 issued July 1997, and in view of Lakritz (hereinafter Lakritz), U.S. Patent No. 6,623,529 issued September 2003.

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B. Whether claims 4, 7-8, and 14-15 are unpatentable under 35 U.S.C. § 103(a), over Motoyama, Fukumochi, and Lakritz, and further in view of Levy (hereinafter Levy), U.S. Patent No. 5,944,790 issued August 1999.

20   C. Whether claims 9-10 and 12-13 are unpatentable under 35 U.S.C. § 103(a), over Motoyama, Fukumochi, and Lakritz, and further in view of BERG, Cliff, "How do I Write an International Application?," Dr. Dobb's Journal, July 1997 (hereinafter Berg).

VII. ARGUMENT
25   (37 C.F.R. § 41.37(c)(1)(vii))

We respectfully urge that two points be noted and recalled frequently while considering the following:

1)   This application was filed in 1998.

30   2)   This appeal is about whether simple variable replacement and dictionary and rule based translation are the same thing. All of the cited references teach inventions for performing

translation, specifically explicit dictionary and rules-based translation. The claimed invention does not perform translation; it replaces variables with previously translated data.

All of the rejections are made under 35 U.S.C. § 103(a). A prima facie case for obviousness on this basis is usually summarized as requiring:

> *To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.* MPEP § 2142

A. The 35 U.S.C. § 103(a) rejections over Motoyama in view of Fukumochi and Lakritz

1. The rejection of claims 3 and 5-6 is technically flawed and also fails to meet the requisite criteria of a prima facie case for obviousness

Claim 3 includes "*a markup-language encoded template having a <u>replacement variable</u> within*" (emphasis added) and other limitations that are explicitly discussed in the text of the office action dated 07/18/2005 (hereinafter the Action).

In the Action at pg. 2, in ¶2 of item 6, the Examiner argues that "*Motoyama teaches a HTML document page translated using a resource dictionary database (file) containing translated words and phrases for replacing variables ... [col. 4, ln. 14-23; col. 5, ln. 41-46; and col. 6, ln. 41-55]; compare with claim 3 'a plurality of resource file containing data for replacing said replacement variable').*"

This is mischaracterization. Motoyama nowhere uses any of the phrases "*resource dictionary database,*" "*resource dictionary,*" "*dictionary database,*" or any variants of these. It also nowhere uses the term "*variable*" or any variants of it. The cite at col. 4, ln. 14-23 merely teaches formatting and distinguishing sections of a document. As such, this does not even support the Examiner's assertion and is irrelevant here. The cite at col. 5, ln. 41-46 states "*It is not critical that every tag or data be translated ....*" This cannot be reconciled with the "*always*"

occurring variable replacement in claim 3. The cite at col. 6, ln. 41-55 teaches the use of dictionaries and rule databases (the latter not to be confused with dictionary or "resource" databases, i.e., what the rules are applied to). Dictionaries and rules are simply not elements in claim 3.

In the Action at pg. 3, ¶1 the Examiner argues that *"Motoyama teaches dictionary resource files indicative of various languages for web page variable replacement* [col. 6, ln. 20-24]." This is further mischaracterization. Again, Motoyama does not teach *"resource files"* or *"replacement variables"* as such reasonably apply in claim 3. It teaches dictionaries and databases of rules that are inherently needed to use those dictionaries. At col. 6, ln. 20-24 Motoyama simply states *"FIG. 4 illustrates an exemplary ... English-Japanese/Japanese-English Dictionary 70 having four separate sections including a copier dictionary 72, a scanner dictionary 84, a printer dictionary 86, and a general English and Japanese vocabulary dictionary 88."* Thus, Motoyama here teaches a dictionary having four different sections, covering three specific different situations (using copies, scanners, and printers) and a general vocabulary dictionary covering other situations.

This (and the rest of the cited paragraph, col. 6, ln. 20-40) also cannot be reconciled with claim 3, which recites:

> a plurality of resource files containing data for replacing said replacement variable, ... each ... containing an idiomatically-correct predefined passage of text in a _different_ language such that said replacement variable will _always_ be replaced with a respective said passage of text governed by the selection of a particular one of said resource files. (emphasis added)

A single passage of text for replacement of the replacement variable thus exists in any given resource file in claim 3. This is clearly not a dictionary, and especially not one like Motoyama's that has four different situational-specific sections to choose definitions from.

It follows that Motoyama does not teach or reasonably suggest multiple elements of the claimed invention that it has been relied upon for, and that a prima facie case for obviousness should not obtain here.

Furthermore, at col. 6, ln. 20-55 Motoyama actually teaches away from the claimed invention. By employing its complex scheme of dictionaries and rule databases, Motoyama is clearly using a different principle of operation. This is leads to another reason why a prima facie case for obviousness should not obtain here, since modifications or combinations of prior art that

change a principle of operation are not obvious. See e.g., MPEP 2143.01 and the case law cited therein.

In the Action at pg. 3, in ¶2, the Examiner further argues:

> ... *Fukumochi teaches a translation system using a dictionary containing idioms of a language as applied to translation from one language to another (Fukumochi Abstract, column 4 lines 64-67 to column 5 lines 1-11; compare with claim 3 "idiomatically-correct").*

However, the conclusion drawn here is error. As the Action itself states, "*Fukumochi teaches a translation system using a dictionary containing idioms* [plural] *of a language*" Yet the resource files of claim 3 each contain only one idiomatically-correct predefined passage of text (singular) with which to replace a replacement variable in a template. These resource files accordingly do not contain idioms (plural) to choose from.

The paragraph in the Action quoted from above ends with the conclusion "*It would have been obvious ... to apply the idioms of Fukumochi to resource files of Motoyama, providing Motoyama the advantage of idioms within its resource files, for accurately translating specialized phrases from one language (and culture) to another*" (emphasis added).

First, this is apparently unsupported conjecture attempting to state a motivation to justify the combination of Motoyama and Fukumochi. There must be some motivation to combine reference teachings and that must appear in the references or in the generally available knowledge (see e.g., MPEP § 2142, quoted above). The Action here is simply silent with respect to the latter, thus failing again to make a prima facie case for obviousness.

Second, the end benefit of this combination is asserted to be accurate translation, but that is irrelevant to claim 3. Accurate translation is not a benefit that claim 3 provides directly. If an inaccurate resource file is used the replacements made by the invention will similarly be inaccurate.

Third, the combination as stated will not work. Motoyama teaches dictionaries (or dictionaries plural, or dictionaries with plural sections – but always something with plural definitions). Fukumochi teaches plural idioms. Without some set of rules to select from among and combine these, the results will be nonsensical. The invention, as recited in claim 3, does not need or have a rules-element to pick from among plural idioms or definitions. Applying the subset of elements of Motoyama and Fukumochi in the manner that the Examiner proposes would therefore not work. It would be unsatisfactory for the purpose of the claimed invention,

and there can be no suggestion or motivation to make a non-workable modification. See e.g.,
MPEP 2143.01 and the case law cited therein.

In the Action at pg. 3, in ¶3, the Examiner next argues:

> *Motoyama teaches markup based translation of Web pages (Motoyama column 4 lines 14-23, also Figure 3). Motoyama does not specifically teach said markup page as a "template". However, Lakritz teaches a multilingual translation method whereby tag based templates are utilized for content translation (Lakritz Abstract, also column 26 lines 47-60, column 5 lines 40-45, column 6 lines 50-65; compare with claim 3 "a markup-language encoded template"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Lakritz to Motoyama, providing Motoyama the benefit of templates which can easily support many languages and countries, as well as easy to add new languages, updating, etc. (see Lakritz column 7 lines 3-11).*

With respect to the first sentence of this, it is addressed by our remarks on the prior
paragraph of the Action. With respect to the second and third sentences, we agree. However,
since Lakritz also teaches translation, using dictionaries with multiple possible choices and
"rules files" and *"rulesets"* to make that all work, whether Lakritz does or does not teach or
reasonably suggest tag based templates is not determinative. What Lakritz, or any combination
employing it, puts into its templates is irreconcilably different than what is in claim 3.

With regard to claims 5-6, we submit that the rejections of these are error for the same
reasons discussed above for parent claim 3.

2.   (Argument: Motoyama, Fukumochi, and Lakritz cont.) The rejection of claims 11, 16,
and 18-20 is also technically flawed and also fails to meet the requisite criteria of a prima facie
case for obviousness

With regard to claim 11, the Examiner's arguments in the Action largely restate what was
already stated for claim 3. In the interest of brevity, we here note differences, discusses those,
and otherwise incorporate by reference our already made remarks.

The one new point raised (in the Action at pg. 4, ¶5) states:

> *Motoyama teaches selection of a dictionary file used to construct a page using translated words from said dictionary file (Motoyama column 6 lines 20-25; compare with claim 11 "selecting one of said plurality of data files", and "constructing an HTML encoded ... replace said variable").*

However, at col. 6, ln. 20-25 Motoyama does not teach selection of a dictionary file, it teaches selection of a situation-specific section (copier, scanner, printer, or general subject matter) within an English-Japanese/Japanese-English dictionary. In contrast, claim 11 recites "*each of said data files having therein a _different language_ data ...*" (emphasis added). In claim 11 definitions are

5   not selected, a data file is selected, and once one is selected the same data portion from it is always used to replace a template variable. This cannot be reconciled with the rule-based use of dictionaries that Motoyama teaches, wherein the rules are necessary to select from among a plurality of candidate definitions based on whichever specific context is encountered.

With regard to claims 16 and 18-20, we submit that the rejections of these are error for

10   the same reasons discussed above for parent claim 11.

Summarizing, Motoyama is the corner-stone reference of all of the rejections, yet it does not teach or reasonably suggest multiple elements of the claimed invention that it has been relied upon for. Different principles of operation among the various references and the claimed invention also cannot be reconciled. And applying the cited references in the proposed manner

15   would be unsatisfactory for the intended purpose of the claimed invention. It follows that the requisite criteria of a prima facie case for obviousness are not met by the rejections.

3. (Argument: Motoyama, Fukumochi, and Lakritz cont.) The rejection of claims 21-22 is also technically flawed and also fails to meet the requisite criteria of a prima facie case for

20   obviousness

With regard to claim 21, the Examiner's arguments largely restate what was already stated for claims 3 and 11. In the interest of brevity we again note differences, discusses those, and otherwise incorporate by reference our already made remarks.

25   The 1st paragraph here is largely the same as the 1st for claims 3 and 11. However, the Action additionally states "... *(Motoyama column 4 lines 14-23, ...; compare with claim 21 'a markup-language encoded....having a replacement variable...* '" (emphasis added). Whereas, the cite to col. 4, ln. 14-23 is totally irrelevant to the argument above for claims 3 and 11, there is some arguable relevance here. Claim 21 recites "*a markup-language encoded template having a*

30   *replacement variable within*" and it appears that the Examiner's point is that variable replacement in templates is taught or suggested by Motoyama. What has been missed, however,

is that claim 21 is here merely reciting a substantially conventional element that is used by its other particularly novel elements, and we have provided extensive remarks herein on why the rejection fails with respect to those novel elements.

With regard to claim 22, we submit that the rejection of this is error for the same reasons discussed above for parent claim 11.

B. (Argument cont.) The 35 U.S.C. § 103(a) rejections over Motoyama, Fukumochi, and Lakritz, and further in view of Levy

Please note, for no apparent reason these rejections were stated in the Action under separate items 7 and 8. In the interest of brevity they are treated together here.

1. The rejection of claims 4 and 7-8 is technically flawed and also fails to meet the requisite criteria of a prima facie case for obviousness

These claims depend from claim 3. As regards Motoyama, Fukumochi, and Lakritz, we have shown above that these do not teach all of the elements of claim 3, that no suggestion or motivation to combine them has been established, and that there is no reasonable expectation of success if their combination is used in place of the claimed invention. Levy does not remedy the deficiencies of these references.

It has never been argued that Levy teaches or reasonably suggests the elements that Motoyama, Fukumochi, and Lakritz are relied on for but fail to teach. In this respect the Action again fails to state a prima facie case for obviousness.

With regard to claim 4, in the Action at pg. 7, in ¶2, the Examiner argues:

> *Motoyama does not specifically teach a language code. However, Levy teaches a country code, which is indicative of a particular language (Levy Abstract; compare with claim 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Levy to Motoyama, because of Levy's taught advantage of country codes, providing Motoyama with a way to process a particular language.*

However, this is just more mischaracterization. Levy teaches a country code for the outright substitution of complete predefined pages when a different language is desired. This is not equivalent to Applicant's language code, which specifies selection of a resource file from

which data is used to replace a replacement variable within a template. Accordingly, Levy does not even teach or reasonably suggest the one element that it is relied upon to justify its combination with the other references used for this rejection.

As for the conclusion stated here in the Action, this is apparently unsupported conjecture attempting to state a motivation to justify the combination with Levy. There must be some motivation to combine reference teachings and that must appear in the references or in the generally available knowledge (see e.g., MPEP §2142, quoted above).

Further, Levy's storing of static pages cannot properly be combined with Motoyama's, Fukumochi's, or Lakritz' dynamic approaches to constructing an end translation result. Such a modification would clearly change the principles of operation of the prior art being combined. To employ the teachings of Levy to store already translated pages would change these references away from a translation tool entirely. Similarly, employing the teachings of these other references to translate a page, on the fly so to speak, would remove from Levy the very reason it uses complete pre-constructed pages. Levy and Motoyama/Fukumochi/Lakritz solve largely the same problem -- but in essentially opposite ways. Modifications or combinations of prior art that would change a principle of operation are not obvious. See e.g., MPEP 2143.01 and the case law cited therein.

Furthermore, applying Motoyama/Fukumochi/Lakritz in combination with Levy in the proposed manner would still be unsatisfactory for the intended purpose of the claimed invention, because such a combination overlooks other elements are lacking in such a combination that would still be required to work. Motoyama, Fukumochi, and Lakritz are inoperable without rules to select definitions or idioms, and Levy merely substitutes entire web pages (and the claimed invention does no do either of these). There can be no suggestion or motivation to make a non-workable modification. See e.g., MPEP 2143.01 and the case law cited therein.

With regard to claim 7, in the Action at pg. 7, in ¶3, the Examiner argues:

> *Motoyama does not specifically teach server side processing. However, Levy teaches a server accepting a web request along with a country code for processing of said web page (Levy column 2 lines 32-46; compare with claim 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Levy to Motoyama, because of Levy's taught advantage of server side processing, providing Motoyama with a way to process a particular language freeing up client resources.*

However, the cited portion of Levy merely describes that it stores its substitute web pages on a server. There is nothing taught or reasonably suggested here that has anything to do with *"building"* or *"combining"* anything. In contrast, claim 7 recites that *"a constructed markup-language code is built at a server by combining said markup-language encoded template and*

5 *data from said resource file."*

With regard to claim 8, the Action relies on the rationale applied to claim 7, from which claim 8 depends. However, in addition to its failings with respect to claim 7, we note that Levy also does not teach or reasonably suggest what claim 8 recites, that a *"server builds the constructed markup-language code by substituting said replacement variable with data from*

10 *said resource file"* (emphasis added).

2. (Argument: Motoyama, Fukumochi, Lakritz, and Levy cont.) The rejection of claims 14-15 is also technically flawed and also fails to meet the requisite criteria of a prima facie case for obviousness

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These claims depend from claim 11. As regards Motoyama, Fukumochi, and Lakritz, we have shown above that these do not teach all of the elements of claim 11, that no suggestion or motivation to combine them has been established, and that there is no reasonable expectation of success if their combination is used in place of the claimed invention. Levy does not remedy the

20 deficiencies of these other references.

It has never been argued that Levy teaches or reasonably suggests the elements that Motoyama, Fukumochi, and Lakritz are relied on for but fail to teach. In this respect the Action again fails to state a prima facie case for obviousness.

With regard to claim 14, other than *"claim 14"* verses *"claim 4,"* the first paragraph of the

25 Action here is the same as for claim 4. Similarly, the second paragraph here is the same as for claim 7.

With regard to claim 15, the Action references the rationale for rejection applied to claim 14, from which claim 15 depends, and we accordingly also incorporate by reference our remarks from above about why this is an error.

30

C. (Argument cont.) The 35 U.S.C. § 103(a) rejections over Motoyama, Fukumochi, and Lakritz, and further in view of Berg

1. The rejection of claims 9-10 is technically flawed and also fails to meet the requisite
criteria of a prima facie case for obviousness

With regard to claim 9, in the Action at pg. 8, in ¶5 (¶2 of item 9), the Examiner states

that "*the use of Java code within HTML (i.e. JavaScript) is known ..., therefore, it would have*

been obvious ... to apply Java code to HTML for the advantage of dynamic applets, etc." We

agree. However, in the next paragraph the Examiner argues:

> *Motoyama does not specifically teach a JAR file containing a Java*
> *ResourceBundle. However, Berg teaches Java in association with a Hot Java*
> *browser, incorporating a JAR file and a Java ResourceBundle to be eventually*
> *run as an applet (Berg p.6 at numbers 5, 6, also p.7 at number 8; compare with*
> *claim 9). It would have been obvious to one of ordinary skill in the art at the time*
> *of the invention to apply Berg to Motoyama, because of Berg's taught advantage*
> *of JAR files and resource bundles, providing Motoyama with a way to utilize the*
> *advantages of said files for its dictionaries.*

As discussed already, however, Motoyama's dictionaries are not equivalent to

Applicant's data files and any speculated advantages that might be provided by those are not

relevant. The Examiner fails to look beyond the use of JAR files, which we have conceded are

prior art, and to look to the content of the JAR files here.

With regard to claim 10, also containing particularized JAR files as subject matter, we

submit that the rejection of this is error for the same reasons discussed above for claim 9.

2. (Argument: Motoyama, Fukumochi, Lakritz, and Berg cont.) The rejection of claims
12-13 is also technically flawed and also fails to meet the requisite criteria of a prima facie case
for obviousness

These claims depend from independent claim 11. In the Action, however, at pg. 9, in ¶3,

the Examiner simply references the rationale for rejection that he used for claims 9-10 (which

depend from claim 3). In the event that our remarks with respect to parent claim 11 are not

persuasive, we respectfully urge that dependent claims 12-13 should still be distinguished by

their additional subject matter, and thus that the rejection of these is error for the same reasons that we have discussed above for claims 9-10.

VIII. CLAIMS APPENDIX
(37 C.F.R. § 41.37(c)(1)(viii))

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The text of the claims involved in this appeal is presented on subsequent pages 18-22 of this brief

1-2 (Cancelled).

1   3. A computer implemented user interface, comprising:

2   a markup-language encoded template having a replacement variable within; and

3   a plurality of resource files containing data for replacing said replacement variable, said

4   replacement variable being selectively replaced by data from a selected one of said resource

5   files, each of the plurality of said resource files containing an idiomatically-correct predefined

6   passage of text in a different language such that said replacement variable will always be

7   replaced with a respective said passage of text governed by the selection of a particular one of

8   said resource files.

1   4. The user interface of claim 3, wherein:

2   said particular one of said resource files is selected according to a language code.

1   5. The user interface of claim 3, wherein:

2   said resource file is an HTML ResourceBundle.

1   6. The user interface of claim 5, wherein:

2   said HTML ResourceBundle is alike in format to a conventional Java ResourceBundle.

1   7. The user interface of claim 3, wherein:

2   a constructed markup-language code is built at a server by combining said markup-

3   language encoded template and data from said resource file.

1   8. The user interface of claim 7, wherein:

2   the server builds the constructed markup-language code by substituting said replacement

3   variable with data from said resource file.

1   9. The user interface of claim 3, and further including:

2   Java code within said markup-language template; and

3   a JAR file containing a Java ResourceBundle.

1   10. The user interface of claim 3, and further including:

2   a plurality of said resource files such that said replacement variable is selectively

3   replaced by data from a selected one of said resource files to produce a constructed markup-

4   language code page;

5   Java code within said markup-language template; and

6   a JAR file containing a Java ResourceBundle; wherein

7   the constructed markup-language code page and the JAR file are transmitted to a

8   browser.

1   11. A method for constructing a web based user interface, comprising:

2   providing an HTML template to a server, said HTML template including at least one

3   variable;

4   providing a plurality of data files to the server, each of said data files having therein a

5   different language data portion corresponding to said variable, the data portion comprising

6   idiomatically-correct predefined content;

7   selecting one of said plurality of data files; and

8 constructing an HTML encoded user interface file by always substituting the same data

9 portion from the selected one of said plurality of data files into said HTML template to replace

10 said variable.

1 12. The method of claim 11, wherein:

2 said HTML template includes Java code; and

3 a plurality of Java ResourceBundles are provided such that when said Java code executes

4 then data from a selected one of said Java ResourceBundles is provided in a Java Applet in the

5 web based user interface.

1 13. The method of claim 12, wherein:

2 the plurality of Java ResourceBundles are combined into a JAR file and transmitted from

3 the server to a browser along with said HTML encoded interface.

1 14. The method of claim 11, wherein:

2 a language code is sent from a browser to the server; and

3 the one of said plurality of data files is selected according to the language code.

1 15. The method of claim 14, wherein:

2 the language code is selected to indicate a particular language such that the one of said

3 plurality of data files is selected according to the language desired.

1 16. The method of claim 11, wherein:

2 each of the plurality of data files is in the form of a ResourceBundle.

17 (Cancelled).

1   18. The method of claim 11, wherein:

2   each of the plurality of data files contains data arranged in key/value combinations such

3   that the key is identical to said variable and the value is the data to be substituted for the variable.

1   19. The method of claim 18, wherein:

2   the key/value pair is delineated by curly brackets; and the key is separated from the value

3   by a comma.

1   20. The method of claim 11, wherein:

2   said variable is delineated within said HTML template by pound signs.

1   21. A computer program product comprising a computer usable medium having a computer

2   readable code embodied thereon configured to operate on a computer, comprising:

3   a markup-language encoded template having a replacement variable within; and

4   a plurality of resource files containing data for replacing said replacement variable, said

5   replacement variable being selectively replaced by data from a selected one of said resource

6   files, each of the plurality of said resource files containing an idiomatically-correct predefined

7   passage of text in a different language such that said replacement variable will always be

8   replaced with a respective said passage of text governed by the selection of a particular one of

9   said resource files.

1   22. The computer program product of claim 21, wherein:

2   said resource files are HTML ResourceBundles that each contain alternative data to be

3   selectively substituted for said variables.

23-24 (Cancelled).

IX. EVIDENCE APPENDIX
(37 C.F.R. § 41.37(c)(1)(ix))

There is no evidence pursuant to § 1.130, 1.131, or 1.132, or otherwise, that has been

5   entered by the examiner and that is relied upon by appellant in this appeal.

X. RELATED PROCEEDINGS APPENDIX
(37 C.F.R. § 41.37(c)(1)(x))

10   The DECISION ON APPEAL for Appeal No. 2004-1077 is presented on subsequent

pages 24-32 of this brief:

The opinion in support of the decision being entered today was <u>not</u> written
for publication and is <u>not</u> binding precedent of the Board.
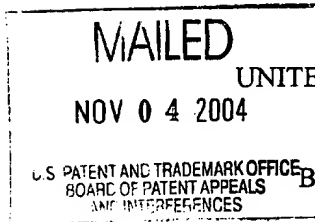
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PI-WEI CHIN, DANIEL GRAHAM DOUGLAS,
EDWARD JOSEPH GALLAGHER and BENJAMIN FRANKLIN YEE

Appeal No. 2004-1077
Application No. 09/161,073

ON BRIEF

Before THOMAS, KRASS and NAPPI, <u>Administrative Patent Judges</u>.

KRASS, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 3-16 and 18-22.

The invention is directed to user interfaces. More particularly, the interface provides

different-language versions of mark-up language resources so that, for example, pages of

documents on the World Wide Web are adapted to varying languages and/or target audiences.

Representative independent claim 3 is reproduced as follows:

3.   A user interface, comprising:

a markup-language encoded template having a replacement variable within; and

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a plurality of resource files containing data for replacing said replacement variable, said replacement variable being selectively replaced by data from a selected one of said resource files, each of the plurality of said resource files containing an idiomatically-correct predefined passage of text in a different language such that said replacement variable will be unambiguously replaced with a respective said passage of text governed by the selection of a particular one of said resource files.

The examiner relies on the following references:

Fukumochi et al. (Fukumochi)	5,644,774	Jul. 1, 1997
Levy	5,944,790	Aug. 31, 1999
		(filed Jul 19, 1996)
Motoyama	6,208,956	Mar. 27, 2001
		(effective filing date may 28, 1996)

Berg, Cliff, "How do I Write an International Application," Dr. Dobb's Journal (July 1997) (Berg)

Claims 3-16 and 18-22 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 3-16 and 18-22 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Motoyama with regard to claims 3, 5, 6, 21 and 22, adding Fukumochi with regard to claims 11, 16 and 18-20, and further adding Levy with regard to claims 14 and 15. With regard to claims 4, 7 and 8, the examiner offers Motoyama and Levy. The examiner offers Motoyama and Berg with regard to claims 9 and 10, adding Fukumochi with regard to claims 12 and 13.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

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OPINION

At the outset, we note that because the amendment after final, filed December 27, 2002 (Paper No. 22), was refused entry by the examiner,[1] the independent claims 3, 11 and 21 before us on appeal are those presented in Appendix X (page 24) of the brief, and include the language that the replacement variable will be "unambiguously" replaced. The dependent claims 4-10, 12-16, 18-20 and 22, before us on appeal are those presented in Appendix IX (pages 20-23) of the brief.

We consider, first, the rejection of claims 3-16 and 18-22 under 35 U.S.C. § 112, second paragraph, since we must first establish whether the claims are definite enough to make it clear to artisans what the metes and bounds of the invention are, and, if applicable, to be able to determine whether the claimed subject matter is amenable to an application of prior art.

It is the examiner's position that the use of the term "unambiguously" is vague and indefinite and it is unclear how this term is to be interpreted within the context of the instant claim limitations.

The inquiry under 35 U.S.C. § 112, second paragraph, is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed—not in a vacuum,

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[1] This decision by the examiner was affirmed (Paper No. 27) on petition.

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but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. In re Moore, 439 F2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Appellants counter that "unambiguously" was used to emphasize that data from a dictionary, having many differing, ambiguous definitions, is not the type of data used by the claimed invention. Appellants also contend that a finding that "unambiguously" is ambiguous is "nonsensical" (brief-page 9). Employing a dictionary definition, appellants contend that something "unambiguous" is "something liable to only one interpretation and also something that is certain and definite" (brief-page 9).

We have reviewed the record and we conclude therefrom that the examiner has presented a reasonable case for showing the indefiniteness of the claims which appellants have not convincingly overcome.

In particular, we find, as did the examiner, that the language "unambiguously" is indefinite as it does not provide the reasonable degree of precision and particularity which is required under 35 U.S.C. § 112, second paragraph. We cannot ascertain what meaning is intended by reciting that a replacement variable will be "unambiguously replaced . . ." If it is only that a replacement variable *will* be replaced with a passage of text, then the insertion of the adverb, "unambiguously," to modify "replaced" would appear to be otiose.

Yet, each word in a claim should be given consideration as to its particular meaning in the claim. But, it is not clear what meaning we are to ascribe to "unambiguously." Appellants

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say that the term was used to emphasize that data from a dictionary, having many differing, ambiguous definitions is not the type of data used by the claimed invention. Appellants appear to be arguing a negative limitation, contending that the term is used to imply something which is *not* part of the instant claimed invention, rather than what, specifically, the invention *is*. If this is appellants' argument, then, clearly, the claims do not particularly point out and distinctly claim the subject matter which appellants regard as their invention, as required by the second paragraph of 35 U.S.C. § 112.

Appellants' statement that something "unambiguous" is "something liable to only one interpretation and also something that is certain and definite" is certainly true, standing by itself. But, in applying the language to the instant claims, we find "unambiguously" to be anything but unambiguous. What does it mean to say that something is "unambiguously" replaced with something else? Is it replaced or is it not replaced? If it is not replaced, then there is no replacement at all, not merely an "unambiguous" replacement. If it is replaced, then, again, there is nothing ambiguous or unambiguous about it. It is merely replaced. The term is subject to too many interpretations as to ascertain any precise meaning to the language. Is it that the replacement act, itself, is "unambiguous" or is it that the thing that is doing the replacing, i.e., the substituted text passage, is "unambiguous"? It is not clear.

Appellants attempted to amend the claims to substitute the word "always" for "unambiguously." While this amendment is not before us, and therefore, we make no determination as to the definiteness of "always," if this is an indication of appellants' intended

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meaning, we cannot agree that "unambiguously" means the same thing as "always." While the former refers to something that is liable to only one interpretation, something certain and definite (as defined by appellants at page 9, lines 21-23 of the brief), the latter refers to something that happens at all times. So, again, the use of the term, "unambiguously" in reciting that a replacement variable will be "unambiguously" replaced with a passage of text, does not particularly point out and distinctly claim the subject matter considered by appellants to be their invention.

As mentioned supra, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. However, the prior art offers no guidance in analyzing the term, "unambiguously" in the context of the instant claims. A traditional, non-technical meaning given to the term, "unambiguously," results in the confusion discussed supra. Yet, when we look to the instant disclosure, we find nothing therein that discusses or defines a replacement variable being "unambiguously" replaced with a passage of text.

Because the claimed term, "unambiguously," offers so many interpretations as to its meaning, within the context of the instant claims, and the instant disclosure offers no particular definition, we find that the artisan would not be able to ascertain the metes and bounds of the patent property defined by the instant claims in the event the instant application should mature into a patent with these claims.

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Accordingly, we will sustain the rejection of claims 3-16 and 18-22 under 35 U.S.C.

§ 112, second paragraph.

Turning to a consideration of the prior art rejections under 35 U.S.C. § 103, we note that,

because of the problem in ascertaining the meaning of "unambiguously," we are in a quandary as

to what the invention defined by the claims actually involves. Accordingly, we cannot resolve

the issues of obviousness with any degree of certainty and will, therefore, reverse the 35 U.S.C.

§ 103 rejection of these claims since one may not properly apply prior art under 35 U.S.C. § 103

if claim interpretation is confusing under 35 U.S.C. § 112, second paragraph. Cf. In re Steele,

305 F.2d 859, 134 USPQ 292 (CCPA 1962).

By making this technical reversal of all prior art based rejections, we do not mean to

imply that the art relied upon by the examiner would not be relevant relative to claims of the

present scope containing definite limitations.

CONCLUSION

We have sustained the rejection of claims 3-16 and 18-22 under 35 U.S.C. §112, second

paragraph. We have not sustained the rejection of claims 3-16 and 18-22 under 35 U.S.C. § 103,

although this reversal is only a technical one.

Accordingly, the examiner's decision is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge   )
)
)
)
)
ERROL A. KRASS   )   BOARD OF PATENT
Administrative Patent Judge   )   APPEALS AND
)   INTERFERENCES
)
)
)
ROBERT E. NAPPI   )
Administrative Patent Judge   )

EAK:clm

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Appeal No. 2004-1077
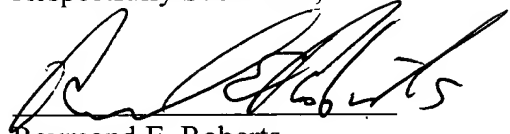Application No. 09/161,073

Intellectual Property Law Office
1901 S. Bascom Avenue, Suite 660
Campbell, CA 95008

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XI. CONCLUSION

Intellectual Property Law Offices
1901 S. Bascom Ave., Suite 660
Campbell, CA 95008

Telephone: 408.558.9950
Facsimile: 408.558.9960

Respectfully Submitted,

Raymond E. Roberts
Reg. No.: 38,597